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In re Application	:
Debets, et al.	:
Application No. 09/775,046	: DECISION ON APPLICATION
Filed: February 1, 2001	: FOR PATENT TERM ADJUSTMENT
Atty Docket No. DX01073K	:

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(b)," filed September 2, 2004. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from zero (0) days to two hundred sixty-two (262) days.

A decision on the request for reconsideration of the patent term adjustment indicated on the patent application is being **HELD IN ABEYANCE** as to the amount of administrative delay the Office incurred for failing to issue the patent within three years of the filing date.

As to the additional adjustment requested as to items A and C on page 2 of the Applicant's "STATEMENT OF THE CORRECT PATENT TERM ADJUSTMENT: GROUNDS UNDER 37 C.F.R. 1.702", this decision will include a determination as to items A and C.

Applicants are given two months from the issue date of the patent to request reconsideration of the patent term adjustment indicated on the patent application. Applicants may seek such reconsideration without payment of the fee. A copy of this decision should accompany applicants' written request for reconsideration.

On June 7, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is zero (0) days. On September 2, 2004, applicants timely<sup>1</sup> submitted an application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is two hundred sixty-two (262) days.

Applicants specifically state that the patent issuing from the application is not subject to a terminal disclaimer.

The Office initially determined a patent term adjustment of zero (0) days based on the following. The above-identified application was filed on February 1, 2001. A Notice to File Missing Parts was mailed on July 5, 2001. Applicants did not respond until November 19, 2001, and accordingly, applicant delay of forty-five (45) days was assessed pursuant to 37 C.F.R. §1.704(b). Next, the PTO mailed a first office action under 35 U.S.C. 132 on July 2, 2002. As this did not occur within 14 months of the application filing date, ninety-two (92) days of PTO delay was assessed pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1).

Applicants timely responded to the July 2, 2002 Office action on September 9, 2002. The PTO mailed another Office action within four months on November 18, 2002, and applicants timely responded on December 12, 2002. The PTO next timely mailed an additional non-final Office action on March 11, 2003. However, applicants did not respond until August 11, 2003. As this response was not within the three month time period pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. § 1.704(b), applicant delay of sixty-one (61) days was assessed.

The PTO mailed timely mailed a final Office action within four months, pursuant to U.S.C. 154(b)(1)(A)(ii) and 37 C.F.R. § 1.703(a)(3), on October 14, 2003. Applicants did not file their reply, an Amendment and a Notice of Appeal, until April 1,

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<sup>1</sup> PALM records indicate that applicants filed the application for patent term adjustment prior to filing the issue fee.

2004. Accordingly, applicant delay of seventy-eight (78) days was properly assessed for the late filing of the Amendment, pursuant to 37 C.F.R. 1.704(b).

In view of the above, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **zero (0) days** (92 days of PTO delay, reduced by 184 days of applicant delay).

However, applicants assert additional PTO delay of two hundred forty-nine (249) days for the failure on the part of the Office to issue the patent within three years of its filing. As the patent has not yet issued, this determination cannot yet be made. Accordingly, applicants are given **TWO (2) MONTHS from issuance of the patent** to seek any additional time based on the Office issuing the patent beyond the three-year time frame.<sup>2</sup> A copy of this letter should accompany the patentees' written request. No additional fee under § 1.18(e) for reconsideration of PTA on this basis will be required.

The \$200.00 fee set forth in 37 C.F.R. §1.18(e) has been charged to Deposit Account No. 04-1239, as authorized.

The application file is being forwarded to the Office of Patent Publication for processing into a patent.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.

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KAF*

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<sup>2</sup> Applicants should note that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period of pendency before the Office except for periods excluded under 35 U.S.C. (b)(1)(B)(i)-(iii), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A).